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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/787,745	01/24/1997	JOHN B. HOEFELICH	29124-009	6904

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/787,745

Applicant(s)

HOEFLICH ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,6 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☒ Claim(s) 8,9,11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The changes to claims 7-9 and 11-21 are agreed with and the rejection under 35 U.S.C. 112, second paragraph, as stated in the Decision by the Board of Patent Appeals dated 23 December 2002 has been removed.

### ***Claim Objections***

3. Claim 7 is objected to because of the following informalities: The word "pint" in line 9 appears to be misspelling of the word – point --. Appropriate correction is required. Claims 8-9 and 11-12 are objected for depending on a objected base claim.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Hogan.

Vincent discloses an elongated tubular shaft (Col. 5, Lns. 65-66) comprising a plurality of layers of fibers embedded in a synthetic resin (Col. 5, Ln. 66 through Col. 6, Lns. 13), a butt section having a diameter between .400 and .540 inches in the form of 12.1 mm (Example 2), a butt section which transitions without intervening discontinuities in the form of the outer surface shape to a tapered intermediate section, a tapered intermediate section transitioning without intervening discontinuities in the form of a outer surface shape to a relatively smaller diameter tip section (Figs. 3, 6), a tip section including a portion having an outside diameter adapted to be fitted to the hosel of a club head, a tip section including parallel sidewalls (Col. 5, Lns. 57-60), a butt section diameter displacing a kick point above a center of a golf club shaft (Fig. 3), a shaft having a conventional shape being truncated along the greater portion of its length (Col. 5, Lns. 55-58), a shaft 41 inches in length (Example 2), and a butt diameter of .476 inches (12.1mm) (Example 2).

Vincent lacks a butt section comprising parallel sidewalls. Hogan discloses a butt section having parallel sidewalls (Fig. 2). In view of the patent of Vincent it would have been obvious to modify the shaft of Vincent to have a butt section having parallel side walls in order to have a similar feel along the butt section when gripped by a player at different points.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Hogan as applied to claims 13-16 and 18 above, and further in view of Kobayashi and Turner.

Vincent discloses a butt diameter of .476 inches (12.1mm) (Example 2).

Vincent lacks a butt diameter between .450 to .475 inches. Kobayashi discloses a player weak in strength requiring a more flexible shaft (Col. 1, Lns. 13-36). Turner discloses making a more flexible shaft by decreasing the outer diameter of a shaft (Col. 8, Ln. 63 through Col. 9, Ln. 4). In view of the patent of Kobayashi and Turner it would have been obvious to modify the shaft of Vincent to have a shaft with a butt diameter of .474 inches in order to provide a more flexible shaft to a weaker player who swings a shaft at a slower speed.

7. Claims 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsuka (5,437,450) in view of Hogan and Iwanaga.

Akatsuka discloses an elongated tubular shaft (Col. 5, Lns. 62-68) comprising a plurality of layers of fibers embedded in a synthetic resin (Figure, Col. 4 Lns. 24-35, Col. 5 Lns. 1-7), a butt section having a diameter between .400 and .540 inches in the form of a grip end inside diameter of 11.5-14.5 mm with a wall thickness of .5-2 mm (Col. 5, Lns. 62-68), a butt section transitioning without intervening discontinuities to a tapered intermediate section, a tapered intermediate section tapering without intervening discontinuities to a relatively smaller diameter tip section in a form of an outer diameter gradually increasing from one end adjacent to a tip end of a shaft to an other end

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adjacent to a grip end of a shaft (Col. 3 Lns. 56-60), a tip section including a portion having an outside diameter adapted to be fitted to the hosel of a club head in the form of an outer diameter size of a tip end (Col. 5, Lns. 62-68), and a shaft length of 45 inches (Col. 7, Ln. 34).

Akatsuka lacks a butt section comprising a substantially cylindrical cross section and a kick point above a center of a shaft.

Hogan discloses a butt section and tip section having parallel sidewalls (Fig. 2). In view of the patent of Hogan it would have been obvious to modify the shaft of Akatsuka to have a butt section having parallel side walls in order to have a similar feel along the butt section when gripped by a player at different points. In addition, in view of the patent of Hogan it would have been obvious to modify the shaft of Akatsuka to have a tip section having parallel side walls in order to facilitate the adaptation of inserting a tip section of a shaft into a neck of a head.

Iwanaga discloses a shaft having a kick point above a center point of a shaft (Fig. 2) for a greater number club in order to ensure controlled swing for exact drop point of a ball (Col. 1, Lns. 41-51). In view of the patent of Iwanaga it would have been obvious to modify the shaft of Akatsuka to have a kick point above the center point of a shaft in order to provide a shaft for a club with a greater number which requires a more controlled swing for exact drop point of a ball.

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8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable Akatsuka (5,437,450) in view of Hogan and Iwanga as applied to claims 13-16 and 18 above, and further in view of Kobayashi and Turner.

Akatsuka discloses a butt diameter of .492 inches (12.5mm) (Col. 5, Lns. 66-68).

Akatsuka lacks a butt diameter between .450 to .475 inches. Kobayashi discloses a player weak in strength requiring a more flexible shaft (Col. 1, Lns. 13-36). Turner discloses making a more flexible shaft by decreasing the outer diameter of a shaft (Col. 8, Ln. 63 through Col. 9, Ln. 4). In view of the patent of Kobayashi and Turner it would have been obvious to modify the shaft of Akatsuka to have a shaft with a butt diameter of .474 inches in order to provide a more flexible shaft to a weaker player who swings a shaft at a slower speed.

#### ***Allowable Subject Matter***

9. Claims 1-3, 5-6, and 19-21 are allowed.

10. Claims 7-9 and 11-12 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

#### ***Response to Arguments***


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11. The argument that claims 13-18 should be allowable due the reasoning of the Board of not agreeing with the Examiner's conclusion with respect to the ranges of the butt end of claim 1 is disagreed with. The Board disagreed with the examiner's butt diameter range due to the claimed tip range diameter in claim 1 and what Akatsuka disclosed for a tip diameter range correlated with the butt diameter range. Claims 13-18 include no range for a tip diameter.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Slb 27 March 2003

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**